

WILLIAM EAMON CARROLL et al.
Application No. 10/799,793

REMARKS

Claims 18 through 29 and 31 through 38 remain before the Examiner for reconsideration.

Claims 18-29 and 31-38 are rejected by the Examiner under 35 U.S.C. 112, first paragraph. Specifically, the Examiner asserted that:

The specification, while being enabling for the use of pH and/or temperature to terminate and/or induce crosslinking, does not reasonably provide enablement for the use of "at least one reaction condition". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The current invention is narrow in scope to several means for terminating a crosslinking reaction, however, the scope of claim 18 encompasses any reaction condition, including such conditions as pressure, concentration of the reactants, volume, reaction time, as well as many other variables that are not included in the specification.

Applicants respectfully traverse the Examiner's rejection.

The issue of enablement set forth in the present case is whether a person of ordinary skill, in light of his own knowledge and the information disclosed in the present application, could control the crosslinking reactions of the present invention (for example, terminate such crosslinking reaction) with a reasonable expectation of success by changing at least one reaction condition. Applicants respectfully assert that the person of ordinary skill in the field of the present invention (for example, polymer synthesis), who is quite likely to have a high level of skill, could readily determine one or more reaction conditions that can be changed to terminate the crosslinking reactions of the present invention. Indeed, the ability to change reaction kinetics, extent of reaction etc. by changing reaction conditions is taught early in, for example, a college chemistry curriculum. Indeed, on the basis of inspection alone, a person of ordinary skill would be able to predict, with a high expectation of success, which reaction conditions (for example, temperature, pressure, pH etc.) could be changed to terminate a crosslinking reaction of the present invention for a given hydrophilic polymer and a given saccharide. To the extent any question remained after such inspection, it would be a routine matter to

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conduct a simple laboratory experiment to determine whether change of a certain reaction condition or combinations or reaction conditions would effect termination of the crosslinking reaction. Numerous examples of such crosslinking reactions are set forth in the specification.

That some routine experimentation may be performed to confirm a determination that a certain reaction condition or combinations or reaction conditions would effect termination of the crosslinking reaction of the present invention does not preclude enablement. As set forth in PPG Industries, Inc. v. Guardian Industries, Corp., 75 F.3d, 1558, 1564, 37 USPQ2d 1618, 1623 (Fed. Cir. 1996):

The fact that some experimentation is necessary does not preclude enablement; what is required is that the amount of experimentation 'must not be unduly extensive'...The Patent and Trademark Office Board of Appeals summarized the point well when it stated: 'The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed to enable the determination of how to practice a desired embodiment of the invention claimed.'

As clear to one skilled in the art, the change of pH and/or temperature to terminate the crosslinking reactions of the present invention were set forth in the specification merely as representative examples of reaction conditions that can be changed. As, for example, set forth in paragraph 44 of the specification "the crosslinking reaction can be terminated prior to completion by, for example, reducing the pH of the composition through the addition of an acid. Emphasis added. Likewise, as set forth in paragraph 10 of the specification, "while the hydrophilic polymers of the present invention form hydrogels with reducing sugars in aqueous solution, cross-linking can be controlled (for example, by control of temperature as described below)." Emphasis added. Once again, one of ordinary skill in the art could readily determine one or more other reaction conditions to be changed to control the crosslinking reactions of the present invention.

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The Examiner also rejected Claim 18 on the ground of "nonstatutory double patenting over claims 45 of U. S. Patent No. 7,090,745". Specifically, the Examiner asserted that:

Claim 18 is rejected on the ground of nonstatutory double patenting over claims 45 of U. S. Patent No. 7,090,745 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the patent and the application are claiming a method of crosslinking a composition of a hydrophilic polymer and a saccharide (sugar) before addition (pregel) and then adding the composition to paper pulp and inducing crosslinking.

Applicants have submitted herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior" Patent, and the appropriate fee in connection therewith. In that regard, the Commission is authorized on the Terminal Disclaimer to charge the associated fee to Deposit Account 02-1065. The Terminal Disclaimer is submitted herewith in duplicate.

The submission of the Terminal Disclaimer is not an admission that the Examiner's rejection of claim 18, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 45 of U. S. Patent No. 7,090,745 is proper.

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In view of the above amendments and remarks, the Applicants respectfully requests that the Examiner, indicate the allowability of the Claims, and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,
WILLIAM EAMON CARROLL et al.

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By /Henry E. Bartony, Jr., Reg. No. 34,772/
Henry E. Bartony, Jr., Esq.
Reg. No. 34,772

Bartony & Hare, LLP
1806 Frick Building
437 Grant Street
Pittsburgh, Pennsylvania 15219-6101
412-338-8632 (telephone)
412-338-6611 (fax)
Attorney for Applicant